

In re Application of:
Chien et al.
Application No.: 09/954,571
Filed: September 11, 2001
Page 4

PATENT
Attorney Docket No.: ST-UCSD3210
(formerly 041673-1001)

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

A. Claim Amendments

Claims 79-85, 92 and 94-96 are canceled. Claims 1-69 and 73-76 were previously canceled. Claims 70, 86, 89, 90-91, 93 and 97 are currently being amended. For ease of reference, a clean set of claims is appended hereto.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

No new matter is added by this amendment. Claim 70 is amended to include limitations previously presented in Claims 83, 92 and 94. The amendments to Claims 86, 89, 90-91, 93 and 97 are to conform the claims to the antecedent basis provided by amended Claim 70, and/or to update their dependencies.

After amending the claims as set forth above, claims 70-72 and 77-78, 86-91, 93 and 97 are now pending in this application. Entry of the amendments is respectfully requested.

B. Terminal Disclaimer

As amended, the present claims are now related to those pending in commonly owned U.S. Serial No. 10/705,791 (U.S. Published Patent Application No. 2004/0121942), which claims the benefit of prior provisional applications filed on November 2, 1998 and July 27, 1999. In the interests of compact prosecution, a terminal disclaimer over a patent that may issue from the 2004/0121942 publication is submitted herewith.

C. Response to Claim Rejections under 35 USC Section 112 (Enablement)

The claims are rejected as lacking enablement on the basis that the specification does not enable “a method of delivering a therapeutic dose of any other PLB mutant [than the S16E mutant], which is capable of treating any cardiac disease caused by any and all factors.” (Action, at pages 2-3, bridging paragraph). The prior amendment to the claims to specify that the cardiac disease treated is heart failure is acknowledged, but enablement is seen as being more narrowly directed to “increasing cardiac contractility,” where the loss of contractility is caused by “phospholamban and SERCA2 interaction” (i.e., suppression of the latter’s activity by the former; Action at page 3, second paragraph).

Without acquiescing in the substantive basis of the rejection, Applicants have amended the claims to recite use of the S16E mutant to treat heart failure associated with loss of cardiac muscle contractility by increasing SERCA2 mediated contractility. Applicants submit that the amended claims are in line with the scope of enablement identified in the Office Action, and are therefore in condition for allowance. To that end, reconsideration and withdrawal of the enablement rejection is respectfully requested.

In re Application of:
Chien et al.
Application No.: 09/954,571
Filed: September 11, 2001
Page 6

PATENT
Attorney Docket No.: ST-UCSD3210
(formerly 041673-1001)

CONCLUSION

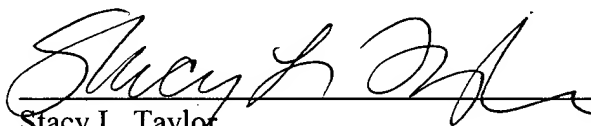
Applicant believes that the present application is now in condition for allowance.
Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Enclosed is a check in the amount of \$125.00 in payment of a Terminal Disclaimer fee (\$65.00) and a Petition for One Month Extension of Time fee (\$60.00). The Commissioner is hereby authorized to charge any other fees that may be associated with this communication, or credit any overpayment, to Deposit Account No. 07-1896. A copy of the Transmittal Sheet is enclosed.

Respectfully submitted,

Date: June 19, 2007



Stacy L. Taylor
Registration No. 34,842
Telephone: (858) 677-1423
Facsimile: (858) 677-1465

DLA PIPER LLP
4365 Executive Drive, Suite 1100
San Diego, CA 92121-2133
USPTO CUSTOMER NO. 28213